

**REMARKS**

Claims 17-59 are pending in the application. Claims 55-59 are allowed. Claims 26, 30, 39, 45 and 53 have been withdrawn from consideration as being directed to a non-elected species. Reconsideration and withdrawal of the remaining rejections is requested in view of the following remarks.

**Response to 35 U.S.C. 102 Rejections**

Claims 17-25, 27, 28, 41-44 and 47-52 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,523,447 to Judge. (Office Action paragraphs 3 and 4.) The Office Action especially notes figure 1 of the '477 patent. Reconsideration and withdrawal of this rejection is respectfully requested.

Applicant respectfully notes that figure 1 of the '447 patent does not show a battery (number 200 in the '447 patent) as required by the claims in the present application. Accordingly, it is respectfully requested that the rejection based on paragraphs 3 and 4 of the Office Action be withdrawn.

Applicant further notes that the Judge patent discloses that the battery may be in one of two places: "The battery 200 may be mounted on housing 17h as shown in FIGS. 3 and 4, preferably in a manner that does not interfere with the chopping action of the saw unit 100" ('447 patent 2:51-53)(see also 4:22-25) or "the battery 200 may also be installed on the base 12 of the chop saw 10 . . ." ('447 patent 2:60-62)(see also 4:26-27). 17h in the Judge patent refers to the motor housing. ('477 patent 2:19-20). And while claim 20 of the '447 patent further recites that "the battery is disposed between the handle and the pivot junction" and claim 21 further recites that "the battery is disposed near the handle," both claims ultimately depend from claim 1 of the '447 patent which recites "a battery having a

battery housing, the battery housing being removably attached to and disposed on the motor housing . . .". Accordingly, the '477 patent does not fairly teach or suggest the limitation in independent claim 17 or dependent claim 43 requiring the battery mounting device and the rechargeable battery to be "disposed at the rear portion of the blade case" as opposed to the motor housing or the base.

Similarly, independent claim 47 recites that the battery mounting device is "disposed on the handle." This placement for the battery mounting device is not shown or fairly taught or suggested in the '447 application.

The '477 patent also does not fairly teach or suggest the further limitation in claim 18 (which depends from independent claim 17) and claim 48 (dependent from independent claim 47) requiring that the blade case "further comprise a handle . . . wherein the battery mounting device is disposed at the rear portion of the handle."

The '477 patent also does not fairly teach or suggest the further limitation in dependent claim 22, independent claim 41 and dependent claim 50 requiring that the battery mounting device be disposed such that when the saw unit is in an uppermost vertical pivot position, the battery center of gravity is positioned on one side of a vertical plane extending through the pivotal axis while the saw unit center of gravity is positioned on the other side of the vertical plane, and such that when the saw unit is in a lowermost vertical pivot position, the battery center of gravity is positioned substantially within the vertical plane.

The '477 patent also does not fairly teach or suggest the further limitation in claims 23, 28, 42 and 51 requiring the battery mounting device and the rechargeable battery serve as a counterweight to the motor when the saw unit is in the uppermost vertical pivot

position. Applicant respectfully notes that the counterweight effect of the battery as claimed in claims 23, 28, 42 and 51 could not be obtained when placing the battery on the motor housing as shown in the '447 patent, nor is such effect suggested in the '447 patent.

### **Response to 35 U.S.C. 103 Rejections**

Claims 29, 46 and 54 stand rejected under 35 U.S.C. § 103(a) over the '447 patent in view of Walker, et al, 6,004,689. (Office Action, paragraph 7.) Reconsideration and withdrawal of this rejection is respectfully requested.

Claim 29 depends from independent claim 17. As explained *supra*, the '447 patent does not disclose or suggest the placement of the battery at the rear portion of the blade case, as required by claim 17. The '689 patent does not cure this deficiency. Accordingly, claim 29 cannot be rendered obvious by combining the '447 patent and the '689 patent.

Similarly, claim 46 depends from independent claim 41. As explained *supra*, the '447 patent does not disclose or suggest the placement of the battery mounting device such that when the saw unit is in an uppermost vertical pivot position, the battery center of gravity is positioned on one side of a vertical plane extending through the pivotal axis while the saw unit center of gravity is positioned on the other side of the vertical plane, and such that when the saw unit is in a lowermost vertical pivot position, the battery center of gravity is positioned substantially within the vertical plane, as required by claim 41. The '689 patent does not cure this deficiency. Accordingly, claim 46 cannot be rendered obvious by combining the '447 patent and the '689 patent.

Lastly, claim 54 depends from independent claim 47. As explained *supra*, the '447 patent does not disclose or suggest the placement of the battery mounting device on the handle, as required by claim 47. The '689 patent does not cure this deficiency.

Accordingly, claim 54 cannot be rendered obvious by combining the '447 patent and the '689 patent.

Claims 31-33 stand rejected under 35 U.S.C. § 103(a) over the '447 and the Examiner's "Official notice that one of ordinary skill in the art would recognize that a belt drive is one of several old and well known drive option between the motor and the saw blade, and would have found it obvious to have provided the '447 with a belt between the motor and saw blade to drive the blade." (Office Action, paragraph 8.) Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 31, 32 and 33 ultimately depend from independent claim 30 [which has been withdrawn from consideration as drawn to a non-elected species]. Claim 30 requires that the blade case, the battery mounting device and the motor be positioned "substantially within the same plane as the saw blade." Claim 31 depends directly from claim 30 and recites, *inter alia*, the further limitations "wherein the motor has a motor shaft that extends in parallel with a rotational axis of the saw blade, and wherein a belt transmits rotation of the motor shaft to the saw blade." Claim 32 depends from claim 31 and further recites, *inter alia*, that the blade case further comprises a handle having a rear portion defined closes to the pivotal axis and a front portion defined farthest from the pivotal axis, wherein the battery mounting device is disposed at the rear portion of the handle. Claim 33 depends from claim 32 and further comprises, *inter alia*, "a switch disposed at the front portion of the handle, the switch manually actuating the motor."

Section 103(a) requires that when considering non-obviousness the invention be considered "as a whole." As the art of record shows, those of ordinary skill in the art generally do not place a miter saw's motor substantially within the same plane as the saw

blade. In fact, apparently the contrary is true, as all the battery powered miter saw art of record shows the motor in a position lateral to the blade's plane. The same can be said of the battery mounting device. Accordingly, Applicant respectfully requests the rejection on this ground be withdrawn.

Claims 34-40 stand rejected under 35 U.S.C. § 103(a) over the '447. (Office Action, paragraph 9.) Reconsideration and withdrawal of this rejection is respectfully requested.

As pointed out by the Examiner, the '447 patent does not disclose the location of the battery and motor substantially aligned in the same plane as the saw blade as required by the claims. Applicant respectfully disagrees with the Examiner's statement that "positioning the battery and motor beside the saw blade, still balances the saw blade when it is in its utmost vertical position." The center of gravity (CG) of the saw will be affected by specific placement of the battery (and the motor in claim 35), given the relative weight of these components in relationship to the other elements of the saw unit that are pivotally attached to the table. The arrangement wherein the CG of the saw unit is substantially within the plane of the blade, or substantially closer to this plane, as opposed to removed laterally as in the art of record, is novel, and is not suggested in the art of record.

While Applicant agrees with the Examiner that placement of certain components in a different position may not always render an article non-obvious, Applicants respectfully submit that when the placement brings advantages not taught or suggested in the art, and particularly when the art teaches away from the solution disclosed and claimed, the arrangement of the components is patentable.

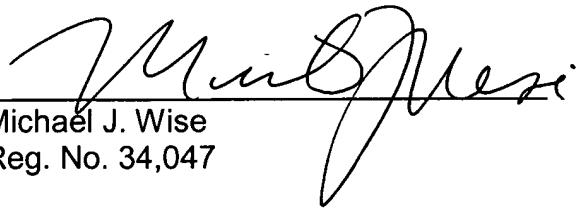
Applicant respectfully notes that the advantages obtainable by the placement of the battery as disclosed and claimed in the present application cannot be achieved when the

battery is mounted on the motor housing as shown in the '477 patent. Applicants further note that when confronted with the particular requirements of placing a battery on a saw pivotally mounted on a table about one, and at times two, axis, the art of record shows that different groups came up with different solutions to the problem. Accordingly, it can be fairly stated that the art of record taught away from the solution comprising, *inter alia*, the placement of the battery and/or the motor as disclosed and claimed in the present application.

In view of the foregoing, it is submitted that the claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner believes an interview may expedite the resolution of any issues relating to the prosecution of the present application, the Examiner is invited to call the undersigned at her earliest convenience.

Respectfully submitted,  
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